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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,629	02/04/2004	Myan Spaccarelli	7294-101	5652
167	7590	04/27/2006	EXAMINER	
FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071			KIM, SANG K	
			ART UNIT	PAPER NUMBER
			3654	

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/772,629	Applicant(s) SPACCARELLI ET AL.	
	Examiner SANG KIM	Art Unit 3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

Claims 25-26 are objected to because of the following informalities: The phrase, "the width of the of the device" should be --the width of the device--. Appropriate correction is required.

Claim Rejections - 35 USC § 112 1st Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant asserts that new claims 25-26 calling for fingers that are longer than the width of the device is supported by figures 1-5. However, these figures do not show any scale and/or is silent as to dimensions comparing the fingers to the width of the device. Furthermore, these claimed features are not supported or described in the specification. Because of the insufficiency of the disclosure, claims 25-26 cannot be meaningfully treated with respect to the prior art at this time.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

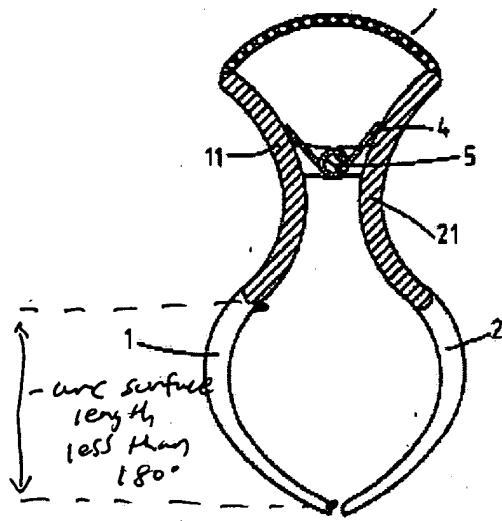
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee, U.S. Patent No. 5803096.

Lee '096 shows a device comprising: opposing clamp members 1, 2 hingedly connected and biased 4 toward a closed position, wherein each opposing clamp member includes a curved inner surface with one or more fingers extending over the material, and handles 7 being adapted to leverage the opposing clamp members into an open position, see figure 7. Note: a recitation for using the device for clamping an unused toilet paper roll or any other roll to prevent unwinding is intended used of the claimed device. If the prior art structure is capable of performing the intended use, then it meets the claim.

With respect to claims 7 and 12, each arcuate surface has an arc length of less than 180 degrees is inherently taught by Lee '096 since each arcuate surface measured from one end to the other end does not extend more than 180 degrees, see figure 6 below.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, U.S. Patent No. 5803096, in view of Loranger, U.S. Patent No. 4137818.

As advanced above, Lee '096 shows all the structural elements of the applicant's claimed device. However, Lee '096 device is for clamping hair rather than a roll.

Loranger '818 discloses a device 56 for protecting and clamping of a roll to prevent accidental pulling off thread winding, see figure 6. Furthermore, the device can be various sizes and the material can be made from spring-like properties, see column 4, lines 55-68.

Since both devices are designed to clamp or hold the material, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Lee '096 by incorporating the roll as taught by Loranger '818 to clamp the roll and prevent the material from unwinding.

Response to Arguments

Claims 25-26 have been added.

Applicant's arguments filed on 3/20/06 have been fully considered but they are not persuasive with respect to claims 1-24.

With respect to claims 1-12, Applicant argues that applicant's claimed device reciting, "[A] combination of curved inner surfaces that extendable around more than one-half of an unused standard paper media roll," gives a specific dimension to the claimed device as explained in paragraph [0010]. Thus, applicant believes that Lee's hair clip is not capable of clamping around a 6" diameter roll.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an unused standard paper media roll to have a specific dimension, especially at least 3" of the outer radius...etc., as explained in the applicant's specification, paragraph [0010]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant is simply relying that by reciting "an unused standard paper media roll, toilet

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paper roll, or paper towel roll” defines a specific diameter to the roll; However, examiner would like to point out that there are many different sizes for toilet paper rolls. Thus, the term “an unused standard paper media roll, toilet paper roll, or paper towel roll,” does not define any specific size since there is no standard size for toilet paper roll.

Furthermore, applicant assumes that Lee’s hair clip is smaller than the size necessary to fit around 6” diameter toilet paper roll or a 9” diameter paper towel roll since Lee does not specify any size to the hair clip. Note, the portable tissue (i.e., Charmin to go bathroom tissue) has a smaller diameter than a 6” diameter roll, which can be clamped by the hair clip. As stated above, Lee’s device shows all the structural elements recited by applicant’s claimed invention.

With respect to claims 13-24, Applicant argues that there is no reason to combine the references since Lee’s device is concerned with a hair clip and Loranger is concerned with a tatting shuttle for thread.

In response to applicant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references deal with clamping.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SANG KIM whose telephone number is 571-272-6947. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:30 P.M. alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki, can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SK

4/24/06

Kathy Matecki
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